

REMARKS

Applicant has corrected the informality in claim 16, per the Examiner's suggestion.

Applicant respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 1 and 2 over Carlson. Claims 1 and 2 recite a fencing system. Among other elements recited in these claims, any one of a plurality of posts interchangeably inserts into, and is frictionally and removably retained by any one of a plurality of stake sleeves. The Examiner contends that Carlson discloses posts 1 slidably, interchangeably inserting into and being frictionally and removably retained by any one of one of stake sleeves in anchors 6. The Examiner states that since Carlson does not disclose use of adhesive, welding, or other joining materials, the posts "may be removably or interchangeably used with anchors 6," as interchangeable alternatives, as shown in Figs. 2 and 3. Office Action, p. 2, lines 24 - p. 3, line 1 (emphasis added).

A claim is anticipated under § 102 "only if each and every element as set forth in the claim is found, either expressly or inherently, described in a single prior art reference." *Verdregal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. §§ 2131.

The specification of Carlson is silent on whether the posts 1 are removably and interchangeably retained by either of ground anchors 5 (Fig. 2) or 6 (Fig. 3). Figs. 2 and 3 just as easily depict alternate embodiments of ground anchors with posts 1 fixed permanently therein. Carlson's silence in respect to the ground anchors 5 and 6 in Figs. 2 and 3 is noticeably in direct contrast to Carlson's express disclosure at col. 1, lines 35-42, that ornamental sections 3 are removably attached to posts 1. Since Carlson does not expressly disclose that posts 1 are removably and interchangeably attached to

ground anchors 5 or 6, the Examiner's § 102 rejection can only prevail if Carlson inherently discloses that the posts 1 are removably and interchangeably attached to ground anchors 5 or 6.

Inherency, however, requires necessity, *i.e.*, in this case, that the disclosure of Carlson necessarily results in the posts 1 being removably and interchangeably attached to ground anchors 5 or 6. "A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. . . . Inherency does not embrace probabilities or possibilities." *Trintec Indus. Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002).

"Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666, F.2d 578, 581 (C.C.P.A. 1981). The Examiner, however, has not stated that the disclosure of Carlson necessarily or inevitably requires that posts 1 be removable from ground anchors 5 or 6. Nor can the Examiner make this argument, because it is untrue. Instead, the Examiner stated that the posts "may be removably and interchangeably used with anchors 6. This is the wrong test for inherency, and it legally fails.

In addition, under M.P.E.P. § 2143.01, the mere capability of a prior art disclosure to be altered to read on claim language does not create a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Since Carlson cannot qualify as a § 103(a) obviousness reference to claims 2 and 3, it uncertainly does not qualify as a § 102(b) anticipatory reference.

For all of the above reasons, Carlson is not a proper § 102(b) reference to claims 2 and 3, and this rejection should be withdrawn.

Applicant also respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 11-15 over Carlson in view of Gibbs; the § 103(a) rejection of claims 1-10 and 16 over Ravert in view of Carlson; and the § 103(a) rejection of claims 11-15 over Ravert in view of Carlson and Gibbs.

Applicant presented arguments distinguishing the claimed invention from Ravert and Gibbs in the Amendment filed on June 14, 2006, and repeats those arguments here. Each of these § 103(a) rejections, moreover, relies on Carlson to disclose posts removably and interchangeably inserted into stake sleeves. For all of the reasons discussed above, Carlson neither discloses nor suggests this feature of the invention as set forth in claims 1-16, and lacking a disclosure or a suggestion of this claim element, the § 103(a) combinations also fail.

In addition, in accordance with *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984), factual considerations to be made in making an obviousness determination include consideration of additional evidence which may serve as “indicia of nonobviousness.” Among the secondary indicia of non-obviousness are commercial success and copying. Attached to this Amendment is a Declaration of Paul L. Gossling, President of the Assignee of the present application, attesting to the commercial success, and copying by a competitor, of a commercial product of the fencing system having the features recited in the present claims.

Applicant includes a Notice of Appeal with this Amendment After Final. Entry of this Amendment is proper after a final rejection in order to correct the minor informality in claim 16, and to make a full record for consideration by the Board of Patent Appeals and Interferences.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 21, 2006
By: 
Reg. No. 27,680 for
James W. Edmondson
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Attachments: Declaration of Paul L. Gossling